

Appl. No. 09/775,411
Amdt. dated 07/21/2004
Reply to the Office Action of 04/22/2004

REMARKS/ARGUMENTS

Reexamination and reconsideration of this application as amended is requested. By this amendment, Claim 8 has been amended. After this amendment, Claims 1-20 remain pending in this application.

Claim Rejections - 35 USC § 103

(1-2) The Examiner rejected claims 1-20 under 35 U.S.C. § 103 as being obvious over Steele et al. (U.S. Patent Pub. No. 2003/0191737) in view of Dillon (U.S. Patent 6,351,467).

Applicants have amended independent Claim 8 to more clearly and distinctly recite the present invention. Specifically, Claim 8 now more clearly recites that the web site is located across a network. Support for this amended language is found in the original specification and claims as filed. See for example the first step in claims 1 and 15. No new matter was added by this amendment to claim 8.

Submitted with this response is a Declaration under 37 C.F.R. § 1.131, executed by the Applicants of the instant application, and associated evidence, to establish that the invention claimed in the instant application was reduced to writing in the United States prior to December 18, 2000. Thus, the invention claimed in the present application was invented prior to December 18, 2000.

The Steele reference cited by the Examiner was filed in the U.S. Patent and Trademark Office on December 18, 2000, which is after the date of invention of the invention claimed in the instant application. Accordingly, Steele is removed as an available prior-art reference and cannot be cited against the present application in a rejection under 35 U.S.C. § 103. The Dillon reference was cited as a combination with the Steele reference, as stated by the Examiner on page 4, lines 4-6, to add Dillon's teaching of passing URLs for dynamic pages to a crawler. Dillon teaches a conventional web

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crawler with the exception that it formats the URL data items into packages. See column 9, lines 52-58. Dillon clearly does not teach or suggest the claimed invention as recited for the present independent claims, and for all dependent claims depending therefrom, respectively. Therefore, it is respectfully submitted that the rejection of claims 1-20 under 35 U.S.C. § 103 should be withdrawn.

Notwithstanding the removal of the Steele reference as an available prior-art reference and consequently that cannot be cited against the present application, Applicants wish to further point out below some clear distinguishing features of the presently claimed invention over any cited reference that is similar to the Steele reference in view of Dillon.

First of all, the Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Steele et al. reference taken alone or in view of Dillon simply does not teach or suggest the claimed invention, as recited for the independent claims, and for all dependent claims depending therefrom respectively, with particular emphasis to the patentably distinct limitation of, inter alia:

... receiving data **from a web site located across a network;**
determining whether additional data **from the web site** is extractable;
... (Emphasis added).

The Steele et al. reference discloses a method for generating an index of data available from a server. In Steele et al., a program called a Server-Based Agent (SBA) **must be present on or attached to each server** in which indexing is to be performed. Steele et al., para. [0075]. In this manner, the SBA can review hypertext links in the pages on the local server (Paras. [0082] & [0185]) and may collect statistical information about the local server, such as the amount of time a user spends on a page, the page the user came from before visiting a particular page, bandwidth statistics of the site, and more.

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Importantly, this information is information that can **only** be obtained with the Steele et al. invention while attached to a **database**, and **not from a website located across a network**, as recited in claim 1 of the instant application. In paragraph 0139 of Steele et al., it is disclosed that the invention scrutinizes **only local websites** to find the **local database**. The steps taken by the SBA requires direct, local database access and cannot be accomplished through an HTTP connection to a remote website located across a network.

Moreover, the SBA performs the discovery steps by examining “form handling programs” (step 1204) which are local programs running on the server. Notably, the code of a local form handling program is not visible on a website. It is therefore apparent that the discovery and indexing is performed on a local database, not a website located across a network and that a web crawler or browser or any other web client would not be able to perform steps 1204-1208 of Steel et al.

Furthermore, Steele et al. discloses installing “database triggers” to automatically update indexing information when changes are made to a database which has been set to be indexed. Para. [0138]. This method applies exclusively to databases and **cannot be performed by using http on a website**. Therefore, Steele et al. does not disclose determining whether additional data from a web site located across a network is extractable, as recited in claim 1 of the instant application.

The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Steele et al. is the utilization of **local** databases to obtain information that is then sent and stored in a remote index database. Steele et al. is completely silent on, inter alia, “receiving data from a web site located across a network” and “determining whether additional data **from the web**

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site is extractable”, as recited for claim 1. The Server-Based Agent cannot meet the intent and purpose of the present invention of “creating at least one synthetic hyperlink for extracting the data from the web site [located across a network]”. **In fact, the premise of the instant invention, and one significant distinction from Steele et al., is that since direct database access is not possible from a remote server, the novel crawler provides a way to gain access that was not possible with the prior art.** The limitations taken “as a whole” in independent claim 1 are not present in Steele et al. taken alone and/or in view of Dillon.

Very recently, the Federal Circuit again took up the identical question of Obviousness in combining references in the case *In re Sang Su Lee*, No. 00-1158 (January 18, 2002). In this case Board of Patent Appeals rejected all of Applicant's pending claims as obvious under § 103. The Federal Circuit vacated and remanded. Citing two prior art references, the Board stated that a person of ordinary skill in the art would have been motivated to combine the references based on “common knowledge” and “common sense,” but it did not present any specific source or evidence in the art that would have otherwise suggested the combination. Here the Examiner on page 4 is citing that “*Dillon discloses the purpose for this practice as allowing the crawler to obtain the content from the dynamic page so as to crawl and index further should this content contain any other URLs*” without more.¹ The Federal Circuit held that the Board's rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action subject to being set aside by the court under the Administrative Procedure Act (APA). Accordingly, without any suggestion or motivation found in Steele et al. in view of Dillon, the Examiner has failed to properly establish a *prima facie* case of obviousness of the invention as a “whole.” The Applicants submit the present invention distinguishes over Steele et al. in view of Dillon for at least this reason as well.

¹ If, however, the Examiner's statements are based on facts within the personal knowledge of the Examiner, the Applicant respectfully requests that the Examiner support these references by filing an affidavit as is allowed under MPEP §707 citing 37 CFR 1.104(d)(2).

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For the foregoing reasons, independent claim 1 distinguishes over Steel et al. in view of Dillon. Claims 2-5 depend from claim 1. Since dependent claims contain all the limitations of the independent claims, claims 2-5 distinguish over Steele et al. in view of Dillon as well, and the Examiner's rejection should be withdrawn.

In paragraph 3 on page 5 of the above-identified Office Action, claim 6 has been rejected as being obvious over Steele et al. (U.S. Patent Pub. No. 2003/0191737) in view of Dillon (U.S. Patent 6,351,467) under 35 U.S.C. § 103.

The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Steele et al. reference taken alone or in view of Dillon simply does not teach or suggest the patentably distinct limitation of:

...receiving a synthetic hyperlink request;
**converting the synthetic hyperlink request to a method
indicated by the synthetic hyperlink request to create a converted
hyperlink request; and**
sending the converted hyperlink request to a web site. (Emphasis
added).

As noted by the Examiner on page 5 of the above-identified Office action, the Steele et al. reference discloses, in paragraphs 0190-0196, the handling of dynamic pages by the SBA. As previously noted, the SBA, contrary to the invention of the instant application, must have direct access to a server's database. "The SBA can either be installed on the same computer as the [HTTP server Directory Tree (HSDT)] or on a computer that allows viewing of all files that are part of the HSDT." Steele et al., para. 0185. As stated in paragraph 0279 of Steele et al., a number of pieces of information related to the dynamic page creation point will be sent by an SBA, including the URL of the form page (fURL in FIG. 18), the URL of the form handling program (fhpURL in

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FIG. 18), the method of the form (GET or POST) (method in FIG. 18), the number of form input fields (fields in FIG. 18), their names (field1 field2 in FIG. 18) and the database columns they correspond to. However, **the SBA only executes an HTTP GET request.** Steele et al., para 0191. Steele et al. does not, inter alia, “[convert] the synthetic hyperlink request to a method indicated by the synthetic hyperlink request to create a converted hyperlink request and [send] the converted hyperlink request to a web site”, as recited in independent claim 6 of the instant application.

The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). **Steele et al. is completely silent on how to convert between a POST and a GET method.** Steele et al. does not explain or recognize that since most existing crawlers can only handle the GET method, synthetic hyperlinks destined for web sites using the POST must be converted to the POST method. (See page 14, lines 9-11 of the instant application). To indicate which synthetic hyperlinks require conversion, the Transcoder 500 of the present invention decides which synthetic hyperlinks require conversion, at step 806, and specially mark those hyperlinks, at step 808. (Page 14, lines 11-14 of the instant application). After the synthetic hyperlinks that require conversion are marked, the synthetic hyperlinks are combined with the data from the web site, at step 810. Generally, the synthetic hyperlinks are inserted into the HTML page from the web site. Finally, the combined data is sent back to the crawler, at step 812, for further processing. (Page 14, lines 17-18 of the instant application). The limitations taken “as a whole” in independent claim 6 are not present in Steele et al. taken alone and/or in view of Dillon.

Very recently, the Federal Circuit again took up the identical question of Obviousness in combining references in the case *In re Sang Su Lee*, No. 00-1158 (January 18, 2002). In this case Board of Patent Appeals rejected all of Applicant's

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pending claims as obvious under § 103. The Federal Circuit vacated and remanded. Citing two prior art references, the Board stated that a person of ordinary skill in the art would have been motivated to combine the references based on "common knowledge" and "common sense," but it did not present any specific source or evidence in the art that would have otherwise suggested the combination. Here the Examiner on page 4 is citing "*Dillon discloses the purpose for this practice as allowing the crawler to obtain the content from the dynamic page so as to crawl and index further should this content contain any other URLs*" without more.² The Federal Circuit held that the Board's rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action subject to being set aside by the court under the Administrative Procedure Act (APA). Accordingly, without any suggestion or motivation found in Steele et al. in view of Dillon, the Examiner has failed to properly establish a prima facie case of obviousness of the invention as a "whole." The Applicants submit the present invention distinguishes over Steele et al. in view of Dillon for at least this reason as well.

For the foregoing reasons, independent claim 6 distinguishes over Steel et al. (or a similar reference) in view of Dillon. Claim 7 depends from claim 6. Since dependent claims contain all the limitations of the independent claims, claim 7 distinguishes over Steele et al. in view of Dillon as well, and the Examiner's rejection of claim 6 should be withdrawn.

In paragraph 4 on page 6 of the above-identified Office Action, claims 8-12 have been rejected as being obvious over Steele et al. (U.S. Patent Pub. No. 2003/0191737) in view of Dillon (U.S. Patent 6,351,467) under 35 U.S.C. § 103.

² If, however, the Examiner's statements are based on facts within the personal knowledge of the Examiner, the Applicant respectfully requests that the Examiner support these references by filing an affidavit as is allowed under MPEP §707 citing 37 CFR 1.104(d)(2).

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The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter “as a whole,” and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention “as a whole.” As discussed above with regards to claims 1 and 6 and the rejections under 35 U.S.C. § 103 (a), the prior art of record, taken alone or in combination with one another, does not teach or suggest a device receiving data from a **website across a network**, as recited in claim 8 of the instant application. Furthermore, the prior art of record, taken alone or in combination with one another, does not teach or suggest “...at least one computer processing device, located across the network from the web site and communicatively coupled to the at least one communication device for analyzing data received from the web site to determine whether additional data is extractable from the web site by a hyperlink request, ...”, as recited in claim 8 of the instant application.

In addition to the above remarks, claim 9 depends directly from amended claim 8. As discussed above, independent claim 8 distinguishes over the prior art of record. Dependent claim 9, therefore, includes all of the limitations of independent claim 8 and distinguishes over the prior art of record. Applicants therefore respectfully submit that the rejection of claims 8 and 9 should be withdrawn.

In paragraph 5 on page 6 of the above-identified Office Action, claims 13-14 have been rejected as being obvious over Steele et al. (U.S. Patent Pub. No. 2003/0191737) in view of Dillon (U.S. Patent 6,351,467) under 35 U.S.C. § 103.

The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter “as a whole,” and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention “as a whole.” As discussed above with regards to claims 1 and 6 and the rejections under 35 U.S.C. § 103 (a), the prior art of record, taken alone or in combination with one another, does not teach or suggest a device **accessing a website across a**

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network. Nor does it teach or suggest a method of converting the synthetic hyperlink request to a method compatible with the web site.

In addition to the above remarks, claim 14 depends directly from claim 13. As discussed above, independent claim 13 distinguishes over the prior art of record. Dependent claim 14, therefore, includes all of the limitations of claim 13 and distinguishes over the prior art of record. Applicants therefore respectfully submit that the rejection of claims 13 and 14 should be withdrawn.

In paragraph 6 on page 6 of the above-identified Office Action, claims 15-18 have been rejected as being obvious over Steele et al. (U.S. Patent Pub. No. 2003/0191737) in view of Dillon (U.S. Patent 6,351,467) under 35 U.S.C. § 103.

The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." As discussed above with regard to claim 1 and the rejections under 35 U.S.C. § 103 (a), the prior art of record, taken alone or in combination with one another, does not teach or suggest, inter alia, a computer readable medium that **receives data from a website across a network** and determines whether additional data from the web site, **located across the network**, is extractable.

In addition to the above remarks, claims 16-18 depend directly from claim 15. As discussed above, independent claim 15 distinguishes over the prior art of record. Dependent claims 16-18, therefore, include all of the limitations of claim 15 and distinguish over the prior art of record. Applicants therefore respectfully submit that the rejection of claims 15-18 should be withdrawn.

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In paragraph 7, on page 6, of the above-identified Office Action, claims 19-20 have been rejected as being obvious over Steele et al. (U.S. Patent Pub. No. 2003/0191737) in view of Dillon (U.S. Patent 6,351,467) under 35 U.S.C. § 103.

The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." As discussed above with regard to claim 6 and the rejections under 35 U.S.C. § 103 (a), the prior art of record, taken alone or in combination with one another, does not teach or suggest, inter alia, **"converting the synthetic hyperlink request to a method indicated by the synthetic hyperlink request to create a converted hyperlink request"**, as recited in claims 19 and 20 of the instant application. Applicants therefore respectfully submit that the rejection of claims 19 and 20 should be withdrawn.

Accordingly, in view of the amendment and remarks above, since neither Steele et al. or Dillon, nor any combination of the two cited references, teaches, anticipates, or suggests, the presently claimed method and system for extending the performance of a web crawler, as recited for the independent claims, and for all dependent claims depending therefrom respectively, Applicants believe that the rejection of Claims 1-20 under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claim.

Conclusion

The foregoing is submitted as full and complete response to the Official Action mailed April 22, 2004, and it is submitted that Claims 1-20 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1-20 is earnestly solicited.

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No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and the attorneys.

The present application, after entry of this amendment, comprises twenty (20) claims, including seven (7) independent claims. Applicants have previously paid for twenty (20) claims including seven (7) independent claims. Applicants, therefore, believe that an additional fee for claims amendment is currently not due.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.

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In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date:

7/21/04

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